

REMARKS

Status of the claims

Claims 13-41 are currently considered.

Claims 13 and 40 are currently amended.

No new subject matter is added by this response.

Brief Summary of Embodiments of the Invention

In one embodiment of the Applicant's invention, a gaming apparatus includes a random number generator; a skill game device that allows a game player to play a skill game, the skill game having a skill game outcome, the skill game outcome being shown to the game player, wherein the skill game outcome may be determined by the player; a processor in communication with the random number generator, the processor configured to randomly determine a prize, the processor configured to calculate a multiplier, the multiplier being a quotient of the prize divided by the skill game outcome; and a display in communication with the processor and the skill game device, the display being configured to display the prize and the multiplier to the player.

In another embodiment of the Applicant's invention, a gaming method includes determining a prize; allowing a player to use skill to determine a skill game outcome while playing on a skill game device; dividing the prize by the skill game outcome to determine a multiplier; displaying the multiplier to the player on the skill game device; and awarding the prize to the player, wherein the prize appears to be the product of the skill game outcome and the multiplier.

Claim amendments

Claims 13 and 40 are currently amended to explicitly define that the skill game outcome is determined by the skill of the player. Support for this amendment can be found throughout the original application, for example, at paragraph [0051].

Claim rejections – 35 USC §103

Claims 13-27, 40 and 41 stand rejected under 35 USC §103(a) as being unpatentable over Bansemer (US 6,780,103) and claims 28-39 stand rejected under 35 USC §103(a) as being unpatentable over Bansemer in view of Bansemer2 (US Pub. No. 2002/0049082). With respect, the Applicant disagrees.

As indicated in the brief summary given above, the invention relates to the idea of allowing a player to play a true game of skill in which their skills directly produce the skill game outcome. By allowing the player to play the skill game, the player is given the impression that their skills affect the game outcome. This effect is enhanced by displaying the player's true game score to the player. However, this non-random skill game outcome would normally conflict with the requirement for the final game outcome to be random. The present invention overcomes this problem by determining a random game outcome (the prize) and then relating the random game outcome to the skill game outcome by calculating a modifier that relates the random game outcome to the skill game outcome.

The rejections of the claims based on the Bansemer reference are best considered with reference to the arguments advanced in the Final Office Action with regard to claim 34. These arguments appear at page 9 of the Final Office Action. The Office argues:

“...Bansemer does teach that the purpose of the invention is to give the player the illusion of playing a skill game wherein the player thinks the outcome of the skill game has a direct impact upon the final reward of the skill game. However, Bansemer teaches that the outcome of the skill game is predetermined”.

That is, the Office acknowledges that Bansemer does not teach a bonus game incorporating a skill game in which the bonus game outcome is randomly determined. The Office acknowledges that Bansemer teaches that the skill game outcome is not randomly determined. The Office Action continues:

“Thus the player will not be able to achieve a higher score or award than the already predetermined (Bansemer 13:21-32)”.

This section highlights the limitations of the Bansemer system and an advantage of the present invention. In the present invention, the outcome of skill game is unencumbered by the required bonus game outcome because the calculated multiplier relates the skill game outcome to the bonus game outcome. Thus, the player can achieve any available score in the game, irrespective of whether this score is greater or less than the randomly determined bonus game outcome. In particular, as described at paragraph [0094] of the present application, usual scoring rules may be applied for the skill game.

The Office Action continues:

“It would be obvious to one of ordinary skill in the art to take the teachings of Bansemer to further specify that the calculation of a modifier such as a multiplier that is the quotient of the prize of the game divided by the skill game outcome (i.e. # skill game shots, tries, etc). This would be

obvious due to the fact that Bansemer discloses that the game award for playing the skill based game is already predetermined randomly by the game processor.

The Office also argues:

“that it would be obvious to one of ordinary skill in the art to use any type of formula or algorithm to give the player the illusion that the score is actually determined by some action of their’s in the skill based game” (underlining added).

This statement from the Office Action is in direct contrast to the true teachings of Bansemer. Bansemer does not teach or suggest the use of modifiers to create the illusion that the player’s skill determines the outcome. Bansemer teaches that in order to create the illusion that a player’s skill determines the outcome, the game must be a very specific game in which visual effects, such as a rapid switching rate or fast target movement, blur any ability for the player to determine whether it is their direct action that is affecting the game outcome. There is no teaching or suggestion in Bansemer that a modifying formula can be applied to the skill game outcome to create the required illusion.

Very importantly, Bansemer does not teach relating a non-random outcome of a skill game to a random game outcome by any formula.

While it is common in the gaming industry to modify outcomes by various modifiers, such as x2 multipliers etc, there will be many modifying formulas that are not obvious. In the present case, the formula is a formula that modifies a non-random outcome so that it equals a randomly determined outcome. Because Bansemer does not teach anything other than a predetermined and random outcome of the skill game, this

particular formula cannot be rendered obvious by Bansemer. **For these reasons, the Applicant contends that the independent claims are not obvious over Bansemer.**

In the section of the Office Action quoted above, the Office indicates that the purpose of the Bansemer invention is to create the illusion that the player's skill affects the outcome of the game. While this may be a similar purpose to the present invention, it is not permissible to distill the invention down to the gist or thrust of the invention. (See MPEP 2141.02 II). The issue is not whether Bansemer and the present invention achieve the same purpose, the issue is whether or not the present invention is obvious over Bansemer. To consider whether the invention is obvious requires the Office to consider the invention "as a whole", in particular the defined limitations of the claims.

Whether or not Bansemer and the present invention have the same purpose is irrelevant. The way in which this purpose is achieved must be fully considered. In the Bansemer case, the purpose i.e. to create the illusion that the skill game outcome affects the bonus game outcome, is achieved by using a skill game in which the movement within the game is so fast that it is not possible for the player to notice that the outcome of the skill game is being determined randomly rather than by the player's own skill. This is very distinct from the present invention, as claimed, in which the outcome of the skill game is determined by the skill of the player and shown to the player. That is, the outcome of the skill game is not randomly determined. Because the outcome of the skill game is not randomly determined, a calculation must be made to relate the outcome of the skill game to the randomly determined outcome of the bonus game. Whether or not the specific relationship (i.e. the quotient) is obvious is irrelevant because the idea of relating a true skill game outcome determined by the player to a randomly determined

outcome is not taught or suggested by the prior nor is it obvious over the prior art. Thus, the particular manner in which the present invention achieves the purpose of the invention, considered as a whole, is not taught or suggested by Bansemer. **For these reasons, the Applicant contends that the independent claims are not obvious over Bansemer.**

In embodiments of the present application, the non-random skill game outcome is displayed to the player. Therefore, the modifier is essential for showing to the player an adjustment of the skill game outcome that has been earned by the player to generate the prize. Importantly, this modifier is displayed to the player so that the player can understand how their earned skill score has been used to generate their prize. From a player point of view, the modifier is the randomizing element. There is no such requirement in Bansemer because the outcome of the skill game is already randomly predetermined. That is, there is no need to randomize the already random outcome. Therefore, the statement by the Office “that it would be obvious to one of ordinary skill in the art to use any type of formula or algorithm to give the player the illusion that the score is actually determined by some action of their’s in the skill based game” is factually incorrect. In Bansemer, the skill game is configured so that the skill game score that is presented to the player has already been randomized at the same time as creating the illusion for the player that their skill has produced the score. There is therefore no need to further randomize this score by displaying a modifier. Thus, any subsequent modification of the score by a modifier would not assist to give the player the illusion that the score is actually determined by some action of their’s in the skill based game. In

fact, any further modification of the score created by the illusory games in Bansemer would detract from the illusion that it was the player's skill that created the score.

The above arguments demonstrate that the use of a true skill game and a quotient to relate a non-random skill game outcome to a random final outcome is not obvious over the teachings of Bansemer. These aspects are embodied in the independent claims 13, 34 and 40 and thus the Applicant contends that **the above arguments demonstrate that claims 13, 34 and 40 and allowable.**

In addition to the arguments presented above, additional aspects of the specific independent claims will now be argued.

Claim 13 defines:

“the skill game outcome is determined by the skill of the player”; and

“the processor further adapted to calculate a multiplier, the multiplier being a quotient of the prize divided by the skill game outcome”

Bansemer does not teach the combination of a skill game outcome that is not random and the calculation of a multiplier that relates the non-random skill game outcome to the prize outcome.

Prior to this response, claim 13 defined that the skill game outcome is influenced by the player. The Office Action states that this element is taught at Bansemer, column 3, lines 6-11, which are reproduced here:

“The player receives the same number of awards regardless of the player's actual skill. The player's skill instead determines the timing of when the game provides or activates one of the predetermined successful outcomes”

In the Advisory Action of 15 April 2010 the Office elaborated, stating that by selecting when to play the game, the player is affecting the skill game outcome in some way. Bansemer teaches directly against the Office's statement in the first sentence of the above section because the skill game outcome, i.e. "number of awards" is the same regardless of the player's skill. That is, the first sentence explicitly teaches that the skill game outcome is not influenced by the skill of the player. The second sentence of the above quote shows that the player may influence the timing of when the skill game is played. However, the first sentence is a direct teaching with a clear and unambiguous meaning and demonstrates that the outcome, which has been predetermined prior to the player selecting when to activate the game, will be the same regardless of the player's timing. Given such an explicit teaching, it is not open to the Office to interpret Bansemer in any other way. Thus, Bansemer teaches that the outcome of the pseudo-skill game is not influenced by the skill of the player.

In the present response, claim 13 has been amended to define that the skill game outcome is determined by the skill of the player. Because Bansemer teaches away from this conclusion, Bansemer does not teach each and every limitation of claim 13. **For these reasons, claim 13 is patentably distinguished from Bansemer.**

Arguments as to why Bansemer does not teach a calculated quotient that relates the skill game outcome to the prize have been advanced above. **For these reasons, claim 13 is patentably distinguished from Bansemer.**

Independent claim 40 similarly defines that the skill game outcome is dependent upon the skill of the player and that a multiplier is calculated that relates the skill game

outcome to the prize. Thus, for the same reasons as advanced above with regard to claim 13, claim 40 is patentably distinguished from Bansemer.

Independent claim 34 defines:

“allowing a player to use skill to determine a skill game outcome while playing on a skill game device”; and

“dividing the prize by the skill game outcome to determine a multiplier”

The arguments for the allowability of claim 34 are similar to the arguments for claim 13. Specifically, Bansemer does not allow a player to use their skill to determine a skill game outcome in combination with awarding a prize that is randomly determined. Bansemer only teaches that the skill game outcome is predetermined and is thus not determined by the skill of the player. **For these reasons, claim 34 is patentably distinguished from Bansemer.**

In light of the foregoing amendments and remarks, the Applicant contends that independent claims 13, 34 and 40 and their respective dependent claims are in condition for allowance and requests that the 35 USC §103(a) rejection of the claims be withdrawn.

Conclusion

For all of the above reasons, the Applicant submits that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this amendment, the Examiner is encouraged to call the Applicant's attorney at (775) 826-6160.

Respectfully submitted,

/ian f burns/

Ian F. Burns

Attorney for Applicant

Registration Number: 33,297